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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,200	02/26/2004	Masami Shimizu	P/16-353	6941

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NEW YORK, NY 100368403

EXAMINER
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LEUBECKER, JOHN P

ART UNIT	PAPER NUMBER
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3739

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/22/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/789,200

Applicant(s)

SHIMIZU, MASAMI

Examiner

John P. Leubecker

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 20, term “medical device” lacks antecedence since it is not a limitation in the previous claim (claim 1). Attempting to further limit an element that is not required by the claim makes the scope of the claim indefinite.

***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1, 3-8, 10-14, 16 are rejected under 35 U.S.C. 102(a and e) as being anticipated by Lee et al. (US 2003/0090352) for the reasons set forth in numbered paragraph 5 of the previous Office Action, paper number 20060730.

As to the newly added limitations, the phrase “operable to designate specified operations in an endoscope unit” recites an intended use and does not positively recite an endoscope unit. Since any switch inherently has at least two positions (e.g., on/off), biasing the switch to the one position (e.g., off) is biased “from another position” (e.g., on).

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taira (U.S. Pat. 4,982,726) in view of Horton (U.S. Pat. 5,701,200) and further in view of Giannini (U.S. Pat. 4,025,885) for the reasons set forth in numbered paragraph 7 of the previous Office Action, paper number 20060730.

Although Taira discloses an “endoscope unit”, such is not required by the claims. Furthermore, as discussed above since any switch inherently has at least two positions (e.g., on/off), biasing the switch to the one position (e.g., off) is biased “from another position” (e.g., on).

***Response to Arguments***

7. Applicant's arguments filed November 7, 2006 have been fully considered but they are not persuasive.

Regarding the Lee reference, Applicant argues that Lee does not disclose or suggest a biasing unit that biases the moving member from another position to the position in which no operation is designated. If it biased to the off position than it is biased from the on position, which is “another position”. The Examiner does not understand how this limitation defines over any conventional switch. For instance, take a conventional wall mounted light switch (which would be encompassed by Lee’s “conventional electrical switch means 120”, [0015]). Such

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switch is biased from one position to another which is evidenced from the fact that gravity does not force it back down when it is placed in the up (vertical) position. This is because the mechanical structure, through some sort of resistance force, biases the switch in either the on or off position. The example given by Lee et al., i.e., a circuit breaker, operates in the same manner.

Furthermore, at least with all the conventional light switches and circuit breakers the Examiner has seen in his lifetime, these switches only require a user force to move the operating member to about a middle position. After that, mechanisms within the assembly provide a variable bias force to further move the switch, automatically, to the intended position.

Additionally, as to further arguments, it is noted since the claims do not require an endoscope unit, Lee et al. does not have to disclose or suggest one.

Therefore, the Examiner maintains the previous position with respect to Lee et al.

Regarding the Taira/Horton/Giannini rejection, Applicant confusingly argues that since Taira fails to explicitly disclose that the body unit is air-tight, it would be difficult for the Examiner to maintain the position that such feature is inherent. However, *this is why the position of inherency is taken—because it is not explicitly disclosed in Taira*. And such position is not difficult at all to maintain. Endoscopes are intended to be inserted into the body and, unless desired to be contaminated with fluids and gases, are designed to be air-tight. The Examiner is not aware of any desirability in the endoscope art to allow contaminants into an endoscope. Unless intended to be disposable after one use, the Examiner is not aware of any endoscope that welcomes inner contamination and then is expected to be used in another procedure. There is no

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indication in Taira that the endoscope is intended to be only used once. Thus, the Examiner takes the position that common sense and logic should prevail here.

However, to backup his position, the Examiner also has cited a reference (Horton) to show that such feature does exist, has been contemplated in this art, and is thought, at least to Horton, to be a typical feature of an endoscope (“Structurally, endoscopes generally include an airtight and waterproof elongated tube...”, col.1, lines 28-41, Horton). Besides backing up the Examiner’s position of inherency, Horton’s statement also suggests to one of mere ordinary skill that an airtight and watertight structure is necessary. Otherwise, why would Horton mention it and why would endoscopes generally be designed that way? The answer is *obvious*. And the Examiner is allowed to take knowledge which falls within the level of ordinary skill into account when ascertaining whether a combination of features is obvious. It is proper to take into consideration not only the teachings of the prior art, but also the level of ordinary skill in the art. In *re Luck*, 476 F.2d 650, 177 USPQ 523 (CCPA 1973). Specifically, those of ordinary skill in the art are presumed to have some knowledge of the art apart from what is expressly disclosed in the references. In *re Jacoby*, 309 F.2d 513, 135 USPQ 317 (CCPA 1962). The Examiner takes the position that one of ordinary skill would be aware of the issue of contamination since this was probably discovered after the first endoscope ever to be invented was used, contaminated, and attempted to be used again (in which case, it either caused an infection in the second person or was not able to be used due to the destruction of the integrity of the optical system, e.g., fogging of lens components).

Since Applicant fails to provide any evidence suggesting that it would not be inherent, nor any evidence that discounts the position of obviousness set forth with respect to Taira in view of Horton, the Examiner has maintained his rejection.

Regarding the Giannini reference, it appears Applicant is arguing that there is no motivation in the cited references. Again, as pointed out above, it is proper to take into consideration not only teachings of the prior art but also the level of ordinary skill and knowledge of the art. The arts involved are switches and endoscopes (and only endoscopes since the Examiner assumed that was the direction the Applicant was going). The Examiner can not envisage how one of ordinary skill would not realize the improved nature, from a perspective of sealing properties of a switch, of using magnetic coupling through a sealed wall, as opposed to a mechanical linkage extending through the wall and sealed with gasket. Although not explicitly stated in the cited references, the motivation is implicitly there and apparent to one of ordinary skill in the art.

Therefore, the Examiner is maintaining the rejection.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

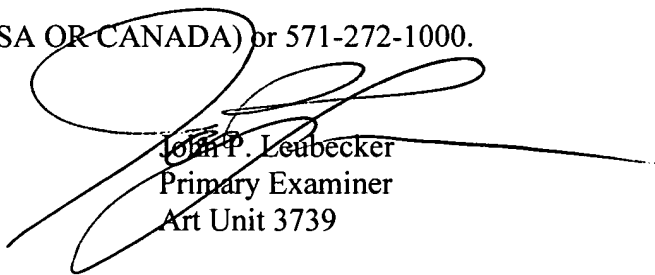
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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John P. Leubecker  
Primary Examiner  
Art Unit 3739

jpl